

### **REMARKS**

By the January 16, 2003 Office Action, Figure 1 is objected to because the elements of the figures are not labeled in accordance with 37 C.F.R. 1.83(a). Also, Claims 1-7, 8, 9-12, 13-33 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hymel et. al. (U.S. Patent 6,157,814) (hereinafter "Hymel et. al. ('814)") in view of Amma (U.S. Patent 6,400,256). Furthermore, Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Hymel et. al. ('814) patent, in view of Abdul-Halim (U.S. Patent 5,604,492). In addition, Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Hymel et. al. ('814) in view of Gaulke et. al., (U.S. Patent 5,737,707). Moreover, Claims 34-38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hymel et. al. ('814), in view of Amma further in view of Hymel et. al., (U.S. Patent 6,031,467) (hereinafter "Hymel et. al. ('467)"). Claims 1, 16, 18, and 19 have been amended. No Claims have been cancelled. Claims 39 and 40 have been added. Therefore, Claims 1-40 are at issue. Reconsideration of these Claims is respectfully requested.

#### **A. DRAWING OBJECTIONS - 37 C.F.R. 1.83(a)**

The drawing in Figure 1 was objected to because the elements of figures are not labeled in accordance with 35 C.F.R. 1.83(a). By this Response, Applicant has amended Figure 2 to show the receiver 11. No new matter has been added. As such, Applicant respectfully requests Examiner to withdraw the objection.

#### **B. CLAIM REJECTION - 35 U.S.C. 103(a)**

##### **1. Rejection of Claims 1-7, 8, 9-12, and 13-33 over Hymel et. al. ('814) in view of Amma et. al.**

Claims 1-7, 8, 9-12, and 13-33 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hymel et. al. ('814) in view of Amma et. al. Applicants respectfully traverse these rejections.

Claim 1 has been amended to specify a controller connected to the receiver and to the LCD driver for sending to the LCD driver a signal comprising the advertising indicia in memory

and a signal comprising an identification of the source of the page in response to receiving the page signal.

Claim 16 has been amended to specify a controller connected to the receiver and to the driver for sending to the driver a signal comprising the advertising indicia in memory and a signal comprising an identification of the source of the communication notifier in response to receiving the communication notifier signal.

Claim 18 has been amended to specify a storage location preprogrammed with advertising indicia, wherein the controller receives the page signal received by the receiver wherein the controller sends to the driver a signal comprising the advertising indicia preprogrammed in the memory and a signal comprising an identification of the source of the page for in response to receiving the page signal.

Claim 19 has been amended to specify providing communication notifying service to the user, wherein the user receives the communication notifier from the source, the advertising indicia stored in the memory of the wireless device will appear on the display of the wireless device, and the source of the communication notifier will appear on the display of the wireless device in response to receiving the communication notifier signal.

Hymel et. al. ('814) fails to disclose, teach, or suggest sending to the driver a signal comprising the advertising indicia in memory and a signal comprising an identification of the source of the communication notifier in response to receiving the communication notifier signal.)

Similarly, Amma et. al. fails to disclose, teach, or suggest sending to the driver a signal comprising the advertising indicia in memory and a signal comprising an identification of the source of the communication notifier in response to receiving the communication notifier signal.)

The law is clear that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by the Examiner. "[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski et. al.*, 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), citing *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Thus, a disclosure that teaches away from, or discourages the making of the claimed invention undermines *prima facie* obviousness.

See *In re Spinnoble*, 405 F.2d 578, 587 (C.C.P.A. 1969). A reference teaches away "when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994). Thus, unless the references suggest the particular combination of elements themselves, they cannot render Applicant's invention obvious. See *In re Mahurkar Patent Litigation*, 831 F. Supp. 1354, 1374, 28 USPQ2d 1801, 1817 (N.D. Ill. 1993).

Both references fail to disclose sending to the driver a signal comprising the advertising indicia in memory and a signal comprising an identification of the source of the communication notifier in response to receiving the communication notifier signal. Further, Hymel et. al. ('814) specifically teaches away from Applicant's claimed invention by disclosing that when the display receives a command from the message processor that a new message has been received and stored in memory, a message indicator is activated. Selection by the end user via the user input of a message indicator associated with the message will display the message on the screen. (Col. 3, Lines 6-12). Thus, any modification suggesting Applicants' claimed invention can only be a result of hindsight analysis. Such an analysis is insufficient to present a *prima facie* case of obviousness. Therefore, Applicants submit that the § 103 rejections of Claims 1, 16, 18, and 19 have been obviated in view of the above arguments. Based on the foregoing, Applicants respectfully request allowance of these Claims.

Claims 2-15, 17, and 20-32 depend directly on Claims 1, 16, and 19 respectively, and include all the limitations of their respective independent claims. Based on the same reasons given for allowance of Claims 1, 16, and 19, Applicants respectfully request that the rejections of Claims 2-15, 17, and 20-32 be removed and the claims allowed.

**2. Rejection of Claim 10 over Hymel et. al. ('814) in view of Abdul-Halim**

Claim 10 is dependent on Claim 1 and contains all the limitations of Claim 1. Based on the same reasons given for the allowance of Claim 1 over Hymel et. al. ('814), Applicants respectfully requests allowance of Claim 10.

**3. Rejection of Claim 11 over Hymel et. al. ('814) in view of Gaulke et. al.**

Claim 11 is dependent on Claim 1 and contains all the limitations of Claim 1. Based on

the same reasons given for the allowance of Claim 1 over Hymel et. al. ('814), Applicants respectfully requests allowance of Claim 11.

4. **Rejection of Claims 34-38 over Hymel et. al ('814). in view of Amma et. al. further in view of Hymel et. al. ('467)**

Claims 34-38 are dependent on Claim 19 and contain all the limitations of Claim 19. Based on the same reasons given for the allowance of Claim 19 over Hymel et. al. ('814), Applicants respectfully request allowance of Claims 34-38.

**CONCLUSION**

In view of the foregoing Remarks, Applicants submit that this application is now in condition for allowance, and such action is respectfully requested. Our check no. 16744 in the amount of \$18 for the addition of two claims is enclosed. If the Examiner believes that a telephone interview would be beneficial, the Examiner is invited to telephone the undersigned attorney at (312) 554-3300.

**RECEIVED**

APR 24 2003

Technology Center 2600

Respectfully submitted,

Dated: April 16, 2003

By:

James P. Muraff

James P. Muraff, Reg. No. 39,785

Wallenstein & Wagner, Ltd.

311 South Wacker Drive, 53rd Floor

Chicago, Illinois 60606-6630

312.554.3300

**CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)**

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service with first class postage prepaid, in an envelope addressed to: Box Fee Amendment, Commissioner For Patents, Washington, D.C. 20231 on

April 16, 2003

Heather M. Pishko

Heather M. Pishko/167028.1